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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,914	09/16/1999	NED HOFFMAN	STA-21	1647

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EXAMINER	
AUGUSTIN, EVENS J	

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
09/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/398,914	HOFFMAN ET AL.	
	Examiner	Art Unit	
	EVENS J. AUGUSTIN	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-72,101 and 102* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-72,101 and 102* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *05/28/08 and 07/28/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The amendment filed on May 28, 2008 has been acknowledged. Claims 1-72 and 101-102 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

4. Claims 1-72 and 101-102 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6012039. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions relate to tokenless biometric computer systems, which do not require the rewards recipient to use any man-made portable memory devices such as smart cards or magnetic swipe cards. The claim language of "formation of a user rule module customized to the user in a rule module clearinghouse, wherein at least one pattern data of a user is associated with at least one execution command of the user;" in the current application is being interpreted as the reward program in Patent No. 6012039.

Claim Rejections - 35 USC §101

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-19, 25-38, and 52-63 and 102 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

7. Based on Supreme Court precedent[1] and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.[2] If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

8. In this particular case, the bodies of the independent claims do not recite any particular apparatus that they are tied to. Therefore, the method claims are not patent eligible methods/processes under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-72 and 101-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shockley et al. (U.S 5534855), in view of Schultz (U.S 5056019).

11. As per claims 1-72 and 101-102, Shockley et al. describes an invention comprising of:

a. ("a user registration step, wherein a user registers with an electronic identicator at least one registration biometric sample taken directly from the person of the user") --an applicant 100 supplies biometric information 105 to a registrar 110 as part of the processing of an account (C.5, LL. 35-37);

b. ("formation of a rule module customized to the user in a rule module clearinghouse, wherein at least one pattern data of a user is associated with at least one execution command of the user") – (C9, L1-13);

c. ("a user identification step, wherein the electronic identicator compares a bid biometric sample taken directly from the person of the user with at least one previously registered biometric sample for producing either a successful or failed identification of the user") --a user identification step, wherein the electronic identicator compares a bid

biometric sample taken directly from the person of the user with at least one previously registered biometric sample for producing either a successful or failed identification of the user (C8, L51-59 and C9, L12-13);

d. ("a command execution step, wherein upon successful identification of the user at least one previously designated rule module of the user is invoked to execute at least one electronic transmission; wherein a biometrically authorized electronic transmission is conducted without the user presenting smartcards or magnetic swipe cards") --

e. Authorization to execute any task is validated at the time a request is made by comparison of the digitized canonical forms of biometric data of the user completing the request with those of the user initiating the request. (C.3, LL.14-33)

12. Shockley et al. did not explicitly describe an invention in which the process being validated is a reward program. However, Shultz describes a reward system in which the consumer is identified using a consumer identification code (C5, LL.2-7).

13. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ biometric identification in a customer reward program because it would provide a more secure environment that better enhances user identification.

14. Shockley et al. also describes a process, taking place in a wide area network (C7, LL.46). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ the internet as the wide area network because the internet is a set of computer networks that may be dissimilar and are joined together by means of gateways that handle data transfer and conversion of messages from the sending networks' protocols to those of the receiving network (Microsoft Computer Dictionary).

Conclusion

15. Applicant is advised to contact the Examiner at the number below to discuss any patentable claims.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is (571)272-6860. The examiner can normally be reached on 10am - 6pm M-F.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

/Evens J. Augustin/
Evens J. Augustin
September 4, 2008
Art Unit 3621